

## REMARKS

In the office action mailed on February 22, 2004, pending claims 7-24 were rejected under 35 U.S.C. § 112, first paragraph, for failing to comply with the written description requirement, and claims 12 and 21 were also rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Claims 7, 9, 16, and 18 were rejected under 35 U.S.C. § 103(a) as being obvious over Cupps et al. (U.S. Patent No. 5,991,739, hereinafter "Cupps") in view of Miller et al. (U.S. Patent No. 4,882,475, hereinafter "Miller"). Claims 8 and 17 were rejected under 35 U.S.C. § 103(a) as being obvious over the combination of Cupps and Miller and in view of an Official Notice that data may be stored on a printout. Claims 10-13 and 19-22 were rejected under 35 U.S.C. § 103(a) as being obvious over the combination of Cupps and Miller and in further view of Suzuki (U.S. Patent No. 6,129,674, hereinafter "Suzuki"). Claims 14-15 and 23-24 were rejected under 35 U.S.C. 103(a) as being obvious over the combination of Cupps and Miller and in further view of Espada-Velasco (U.S. Patent No. 5,802,890, hereinafter "Velasco").

### Applicant's Invention

Applicant's invention is entitled "Automated Cafeteria." That title refers to a system that enables a customer to remotely order a meal and then travel to the cafeteria where the corresponding prepared order is obtained and purchased at an automated check-out station. The claims are directed to the components of the system that support the verification of the prepared order as corresponding to

the remotely communicated order so the correct order is picked up by the customer.

### Obviousness Rejection

Examiner has rejected the pending claims under 35 U.S.C. § 103(a) primarily in view of Miller and Cupps. Examiner has found several references that disclose the remote ordering of food items. Examiner has found references that relate to the delivery of remotely ordered menu or catalog items to a customer. However, Examiner has not found a single reference that teaches or suggests the use of an automated station to verify a prepared order as being a particular one that was remotely ordered so it is released to a person presenting data confirming the verified correspondence. Furthermore, Examiner has failed to demonstrate any teaching or suggestion to modify the cited ordering or delivery systems to provide an automated order verification system for release of prepared orders to an appropriate person. Consequently, Examiner has failed to present a *prima facie* case of obviousness. Instead, the silence of the cited references regarding an automated check-out station that is capable of order verification is compelling evidence that the invention of the pending claims is not obvious and that the claims should be allowed.

This silence is also the basis for Applicant's arguments that Examiner is using hindsight to make the obviousness argument. Specifically, Applicant's specification and claims teach a system that includes an automated check-out station for verifying an assigned order number against an order number on a label for a prepared order for the purposes of confirming the release of the

prepared order to the person at the automated check-out station. Examiner cannot cite any reference that teaches or suggests such an automated component for this purpose. Accordingly, discovery of an automated check-out station in any reference cited by Examiner is improper modification of the reference to incorporate the disclosure of Applicant's specification and claims. Such modification cannot be used to support an obviousness rejection. Instead, it is evidence that Examiner is reading Applicant's disclosure and invention into the cited reference or combination of references.

Without a reference disclosing an automated check-out station that reads or retrieves an assigned order number from a storage unit for the purpose of verifying the correspondence of the assigned order number with an order number on a label, Examiner cannot support a *prima facie* case of obviousness. Examiner attempts to overcome this deficiency by modifying components in a reference, such as the driver check-out station in Miller, to provide such a verification function. Even if the component is capable of being modified to provide the claimed invention, the reference does not, in fact, disclose the claimed inventive element without a teaching or suggestion that the component be so modified. In Miller, there is no discussion of customer pick-up at the driver check-out station that involves order number verification. Examiner's citation to column 4 of the Miller specification is inapposite because Miller only states that the order entry station includes a point of sale terminal if customer pick-up and payment occurs. There is no teaching or suggestion that the customer provide any storage unit containing an assigned order number so that it may be read and

verified as corresponding to an order number on a label for a prepared order. Consequently, the obviousness ground of rejection should be withdrawn.

#### Section 112 Rejections

Examiner has rejected claims 7, 16 & 19 under 35 U.S.C. § 112, first paragraph, for failing to comply with the written description requirement because “an automated check-out station retrieving the assigned order number from the storage unit of the computer” was not adequately described in the specification to convey possession of the invention at the time that the application was filed. Claims 11, 13, 20, and 22 were also rejected on the same ground because the limitation of “an automated check-out station retrieving the assigned order number from a stored-value card” was not adequately described in the specification. Applicant disagrees with Examiner’s narrow reading of the specification and submits the following sections of the specification as adequately describing the invention embodied by the cited limitations.

At page 4, line 19 to page 5, line 18, the specification discloses multiple ways in which an assigned order number may be stored for presentation at the automated check-out station. To assure delivery of an order and that the delivery is made to the proper person at an automated check-out station, several approaches are discussed at pages 9 and 10 of the specification. These approaches include the use of smart cards and stored-value cards. See, e.g., page 10, lines 19-20. These types of cards were described as storage units for the assigned order number in the specification at page 5, lines 5-18. Retrieval of

data from cards, such as identification cards at an automated teller machine, is disclosed for the automated check-out station. See page 9, lines 2-4. Thus, the specification does inform one of ordinary skill in the art that an assigned order number may be stored by a computer used to place an order remotely and then that stored value may be read or retrieved at the automated check-out station for verification purposes. Additionally, the specification at page 4, line 24 to page 5, line 5 describes the storage of an assigned order number in a PDA so that the PDA may be carried to the cafeteria for order verification purposes. The order number may be read, retrieved, or otherwise obtained from the PDA at the automated check-out station so that the assigned order number from the PDA may be verified against the order number read from a label on an order presented at the automated check-out station. The PDA may be in direct communication with the automated station for this verification. See page 10, lines 5-14. Therefore, the limitation of "an automated check-out station retrieving the assigned order number from the storage unit of the computer" is adequately described for section 112, first paragraph purposes. Examiner rejected claims 8, 10, 12, 14, 15, 17, 21, and 23-24 because they depended from claims 7 and 16. Consequently, the support noted above also addressing Examiner's ground of rejection under 35 U.S.C. §112, first paragraph, should be withdrawn for these claims as well.

Examiner has also rejected claims 9 and 18 under 35 U.S.C. § 112, first paragraph, for failing to comply with the written description requirement because "an automated check-out station retrieving the assigned order number from the

printed bar code" was not adequately described in the specification to convey possession of the invention at the time that the application was filed. However, Applicant has stated in the specification at page 4, lines 18-24, that the assigned order number may be printed on paper in bar code format for later machine recognition. As noted above, transportation of the paper bearing the bar code to the automated check-out station for order verification is disclosed. One of ordinary skill in the art recognizes that bar code readers are incorporated within automated check-out stations for reading bar codes. Thus, Applicant's specification describes an automated check-out station that uses a bar code reader to read the assigned order number for the purpose of verifying correspondence of the assigned order number with an order number on a printed label for release of the order to an appropriate party. Thus, the section 112, first paragraph, ground of rejection for claims 9 and 18 should be withdrawn.

Examiner rejected claims 12 and 21 under 35 U.S.C. §112, second paragraph for failing to distinctly claim the subject matter regarding as Applicant's invention. In response to this ground of rejection, Applicant has amended claim 12, cancelled claim 21, and submitted new claim 25. As the amended claim 12 and new claim 25 resolve the alleged ambiguity, Applicant submits that this ground of rejection be withdrawn.

#### Claim 7

Examiner rejected claim 7 under 35 U.S.C §103(a) as being obvious over Cupps in light of Miller. Examiner specifically relies upon Miller for the disclosure of an automated check-out station for verifying the correspondence of an

assigned order number with an order number printed on a label. As noted above, Miller does not contain such a disclosure and, therefore, this ground of rejection must fail. Miller does not disclose an automated check-out station, but rather a driver check-out station that does not support automated customer pickup of prepared orders. There is no teaching or suggestion of the presentation of an assigned order number at the driver check-out station from a storage unit that obtained the assigned order number during a remote ordering procedure. The data entered by the driver in Miller at the driver check-out station is not verified as corresponding to the order data but rather is correlated to order data so responsibility for delivery of the order is recorded. However, there is no teaching or suggestion that the order is released to the driver because an assigned order number obtained during remote ordering of an item is entered by the driver and verified to correspond to an order number on a generated label. Instead, Examiner has used Applicant's specification to so modify the driver check-out station without citing any motivation to change the driver's station in this manner. Such use cannot legitimately support a *prima facie* case of obviousness and, the rejection should be withdrawn.

#### Claim 16

Examiner rejected claim 16 under 35 U.S.C. §103(a) over Cupps in view of Miller. Again, Examiner is combining the ordering system of Cupps with the driver station of Miller used for order delivery as support for this rejection. However, as noted above, the driver station of Miller does not perform the function of verifying the correspondence of the assigned order number retrieved

from a storage unit that obtained the number during the ordering process. Examiner implicitly notes this deficiency by stating that "the driver check-out station 70 corresponds to the automated check-out station where the bar code label is check, identified and verified." Official Action of February 22, 2004, page 20, lines 2-4. This statement ignores a number of claim limitations. For one, claim 9 requires the verification of a *correspondence* between the assigned order number and the order number on the generated label. The above quoted statement from the Official Action fails to identify what the bar code label is being verified against. The reason for this oversight is that the bar code label is not read for verification against an assigned order number that has been transported to the driver station from a computer used to place the order remotely. Thus, the Miller reference does not disclose this correspondence verification and, the combination of Cupps and Miller is likewise deficient.

Another limitation of claim 16 not disclosed in Miller is the storage unit brought from the computer from which an order was remotely placed for the purpose of correspondence verification. Miller only discusses the input of driver identification data using a key or hand held data unit. However, Miler does not teach nor suggest the use of these devices to place an order remotely. Thus, the system of Miller does not address the need of verifying transported order data against order data on a generated label.

For at least these reasons, claim 9 should be allowed over the references of record.



#### Claim 16

Examiner rejected claim 16 as being obvious over the combination of Cupps and Miller. However, as noted above, Miller does not disclose the verification of correspondence between an assigned order number and an order number on a generated label. Miller also does not disclose the retrieval of an assigned order number from a storage unit that obtained the assigned order number during placement of a remote order. Consequently, there is no motivation or teaching to modify Miller to perform such a method and the obviousness ground of rejection should be withdrawn.

#### Claim 18

Examiner rejected claim 18 as being obvious over the combination of Cupps and Miller. However, Miller does not teach the performance of assigned order number verification that determines whether an assigned order number retrieved from a bar code printout corresponds to the order number on a generated label. Thus, this claim is allowable over the references of record.

#### Claim 8

Examiner rejected claim 8 as being obvious over Cupps in view of Miller and the Official Notice. Applicant agrees that Official Notice may be taken that data can be stored on paper. However, the retrieval or reading of that information for the purposes of verifying correspondence of a retrieved assigned order number with an order number on a generated label is not disclosed in any cited reference and no Official Notice of such a function may be made. Furthermore, the combination of Cupps and Miller does not provide an adequate

foundation to which Examiner may add the Official Notice for reasons set forth above. Therefore, the rejection of claim 8 is unsupported and should be withdrawn.

#### Claim 17

Examiner rejected claim 8 as being obvious over Cupps in view of Miller and the Official Notice. Applicant agrees that Official Notice may be taken that data can be printed on paper for storage of data. However, the retrieval or reading of that information for the purposes of verifying correspondence of a retrieved assigned order number with an order number on a generated label is not disclosed in any cited reference and no Official Notice of such a function may be made. Furthermore, the combination of Cupps and Miller does not provide an adequate foundation to which Examiner may add the Official Notice for reasons set forth above. Therefore, the rejection of claim 17 is unsupported and should be withdrawn.

#### Claims 10-13 and 19-22

Examiner rejected claims 10-13 and 19-22 as being obvious over Cupps and Miller and in further view of Suzuki. For reasons noted above, the Cupps/Miller combination does not provide a foundation for Examiner's ground for rejection and, consequently, the rejection should be withdrawn. Suzuki was cited for teaching the use of a stored value card for storing data so that "the same information can be read later to correlate and verify merchandises." However, Suzuki does not address the problem of releasing goods to a user and, therefore, does not teach the use of a stored value card in verifying a

correspondence between an assigned order number stored in the stored value card and an order number on a generated label. A user may tender payment for goods remotely ordered at various locations in a store, but those goods, if picked up by the customer, are not subjected to correspondence verification before release of the goods. That is, the POS terminal reads the transaction history from the card, transmits it to a stock room or warehouse where the goods are pulled and collected for customer pickup (Col. 7, line 58 to Col. 8, line 14). However, there is no discussion or suggestion that the stored value card be taken to the stock room, warehouse, or pickup point for retrieval of an order number from the card so it may be verified as corresponding to an order number associated with the collected goods. Even more important is the lack of any suggestion to provide an automated check-out station at such locations for the unattended pickup of collected goods using a stored-value card or PDA. Consequently, Suzuki does not supply any teaching or suggestion of Applicant's invention. For at least this reason, claims 10-13 and 19-22 should be allowed.

Claims 14-15 and 23-24

Claims 14-15 and 23-24 were rejected as being obvious over Cupps/Miller and in further view of Velasco. Because the ground of rejection relies upon the Cupps/Miller combination, it should be withdrawn for the reasons noted above regarding the failure of this combination to teach or suggest the system of Applicant's invention. Furthermore, the invention of claims 14-15 and 23-24 requires that the basket be responsive to an automated check-out station that verifies the correspondence of an assigned order number retrieved from a

storage unit that obtained the assigned order number during a remote ordering of menu selections. The Velasco reference makes no reference to an anti-theft device responding to an automated check-out station. Instead, Velasco refers to magnetic labels that combine with anti-theft devices in commercial establishments to trigger an acoustic alarm. This reference appears to suggest RFID interrogators that may trigger an acoustic alarm upon detection of an RFID tag. However, Examiner has provided no teaching or suggestion to modify an RFID interrogator to include an automated check-out station and certainly there is nothing of record that suggests any modification to provide the automated check-out station that performs the correspondence verification of the present invention.

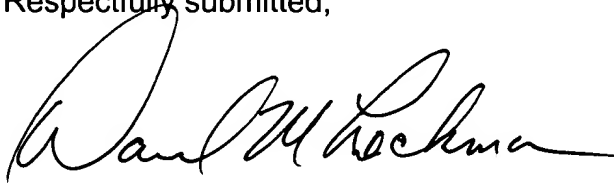
Examiner has also failed to set forth any basis for modifying the system of Miller so the food items are stored within baskets so an automated check-out station detects unauthorized removal of a basket. The alarm disclosed in Miller is for the purpose of preventing a driver from leaving with an order without being correlated to it. One would not modify the system of Miller to include baskets for the food items because it would add an unnecessary expense. Also, the anti-theft device of Velasco and Applicant's basket are used because the orders are provided in a publicly accessible environment. Such baskets would not be viewed as being worthwhile in Miller because the food items are not publicly accessible. Therefore, Examiner has failed to demonstrate that one of ordinary skill in the art would be motivated to combine Velasco with Miller. Even more importantly, there is no teaching or suggestion to combine the two references

and then further modify the driver station of Miller to provide correspondence verification so an order may be removed from a basket. For at least these reasons, claims 14-15 and 23-24 should be allowed over the references of record.

### **CONCLUSION**

For the reasons set forth above, claims 7-25 should be allowed over the references of record. Entry of all amendments and reexamination of all presented claims are requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "David M. Lockman". The signature is fluid and cursive, with a large initial "D" and "L".

David M. Lockman

Reg. No. 34,214